

Application Serial No. 10/679,224
Amendment dated 4/25/2007
in Response to Office Action dated 10/25/2006

REMARKS/ARGUMENTS

In the Office Action, the Examiner noted that claims 1-33 and 43 are pending in the application and that claims 1-33 and 43 are rejected. By this response, no claims have been cancelled or added. Thus, claims 1-33 and 43 are pending in the application. A request for reconsideration is presented here.

Twice in previous amendments filed, Applicants have requested that the title of the invention be amended as follows: "Fishing Poles, Counter-Balancing Apparatus for Fishing Poles and Fishing Pole Handles, ~~and Methods for Balancing Fishing Poles~~". Applicants first made this request in the Preliminary Amendment filed on March 22, 2004 and made the second request in the Amendment to Non-Final Rejection filed on January 10, 2005. The change is not reflected on the USPTO website and Applicants herein once again request that this amendment to the title be made.

Rejections Under 35 U.S.C., §102

Claims 1-4, 6-8, 16-20, 22-24 and 43 are rejected under 35 U.S.C. §102(b) as being anticipated by *Vogts, et al.* (U.S. Patent 5,369,904). Applicants traverse the Examiner's assertion because the Examiner has not provided a prima facie case of anticipation with respect to *Vogts, et al.*

In order to prove a *prima facie* case of anticipation, the Examiner must provide 1) a single reference 2) that teaches or enables 3) each of the claimed elements (arranged as in the claim) 4) expressly or inherently 5) as interpreted by one of ordinary skill in the art.

Here, the Examiner has not provided a single reference that teaches or enables each of the claimed elements as arranged in the claims, expressly or inherently. More particularly, *Vogts et al.* (at Fig. 7) merely teaches the provision of a single weight (see weight 704) that can be selectively positioned along an extension rod 702 via a latch arm 714 that couples into one of a plurality of individually selectable notches 710. The provision of latch arm 714 prevents the immediate positioning of weight 704 in "abutting relation" with adjacent weights, as well as with "butt end 708" of the rod (see column 5, lines 63-68 through column 6, lines 1-16).

Claims 1, 18, 26 and 43 recite that the weights are provided in "abutting relation" relative to each other, as well as relative to an adjacent handle portion. For example, amended claim 18 provides a handle portion having an adjacent portion with a plurality of stackable weight members placed in conforming abutting relation substantially with an outer surface of the at least one handle portion so as to provide an outer hand grip surface. Nowhere are these elements taught or enabled by *Vogts et al.* Instead, *Vogts et al.* teaches a weight 704 with a latch arm 714 that prevents weight 704 from being "...provided in abutting relation ..." with butt end 708 of the rod. Accordingly, the limitations of claim 1 are not taught or enabled by *Vogts et al.* Further, the devices in Figures 1 and 2 of *Vogts et al.* do not teach or enable this claim limitation because a single weight 40 is merely taught attached to an extension rod 38 that is either contiguous with rod blank 20 or is a separate rod, fixedly, slidably, or detachably coupled to the proximal end 24 of the handle section 14. There is nothing in *Vogts et al.* that teaches or enables, "...a plurality of

stackable weights ...each provided in abutting relation ...having a cross-sectional outer surface profile of an end portion of the handle portion such that the handle portion and the plurality of stackable weights cooperate to provide a handle grip surface.” (see claim 1).

Independent claims 18, 26 and 43 recite similar claim limitations, “...substantially equal outer surface radius ...in abutting relation substantially with an outer surface of the at least one handle portion” (claim 18); “...weight members in adjacent abutting relation along an end of the handle portion ...an outer surface of the stackable balancing weight members providing an outer grip surface with a cross-sectional surface profile that substantially matches a cross-sectional surface profile of the end of the handle portion so as to extend an outer grip surface of the handle portion” (see claim 26); and “...a plurality of stackable mass members ...in adjacent abutting relation ...having a complementary outer surface portion ...to provide a conforming outer surface of the mass member substantially matching the outer surface portion of the structural member so as to provide a handle with a surface hand grip carried by the structural member for custom tailoring balance of the handle” (see claim 43). Nowhere are the claim limitations taught or enabled by the cited prior art reference.

The provision of weights provided in abutting relation to one another as well as to an adjacent handle portion in conforming abutting relation with an outer surface of the handle portion is important because the resulting balanced handle assembly provides an accommodating grip for a user’s hand. Secondly, many fishing poles are supported by complementary, tubular fishing pole holders that are provided on the gunwale of fishing

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boats. The conforming abutting relation accommodates support and stowage of a balanced fishing pole handle in such fishing pole holders without increasing the risk that an enlarged or ensmallled weighted portion (see prior art designs) will snag on the edge of the pole holder while withdrawing the handle from the pole holder in order to retrieve a fish.

There exist legal standard for anticipation and obviousness rejections which are not being met by the Examiner. The Examiner is not complying with the MPEP, 37 CFR, or 35 USC requirements for rejection the claims. If this continues, Applicants will be forced to file an appeal brief to address this improper standard of rejection.

Accordingly, claims 1-4, 6-8, 16-20, 22-24 and 43 clearly overcome the anticipation rejection under 35 U.S.C. § 102(b) by *Vogts et al.* Because the Examiner has again failed to provide a proper prima facie anticipation rejection, Applicants herein request an interview with the Examiner and the Examiner's supervisor in order to further expedite prosecution of the present application in the event that the next office action does not include allowable subject matter. Applicants are wasting resources arguing with the Examiner over improper standards of rejection.

Withdrawal of these rejections is respectfully requested.

Rejections Under 35 U.S.C., §103

Claims 5 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Vogts, et al.* as applied to claims 3 and 19 above, and further in view of *Ries* (U.S. Patent 5,060,412). Applicants traverse the obviousness rejection. Applicants herein repeat the

shortcomings of *Vogts et al.* as not teaching or enabling the missing limitations described above with reference to the improper anticipation rejection. The same applies to an improper obviousness rejection.

In order for the Examiner to establish a *prima facie* case of obviousness, the Examiner must provide 1) one or more references 2) that were available to the inventor and 3) that teach 4) a suggestion to combine or modify the references, 5) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. Here, the Examiner has not established appropriate teachings, or a basis for a suggestion to combine or modify the recited references in a manner that would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

There is no teaching or suggestion of the “plurality of stackable weights ...having a cross-sectional outer surface profile configured in assembly to match a cross-sectional outer surface profile of an end portion of the handle portion such that the handle portion and the plurality of stackable weights cooperate to provide a hand grip surface...” along with “...a first handle portion ...and second handle portion removably attached to the first handle portion ...wherein the first handle portion is configured to pivot relative to the first handle portion about a point where the second handle portion attaches to the first handle portion.” (see claim 5, and claim 21 for similar language).

Claims 9-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Vogts, et al.* as applied to claims 3 and 19 above, and further in view of *Dahlberg* (U.S.

Patent 5,355,611). Applicants repeat the arguments above with respect to the lack of teaching or enablement by *Vogts, et al.* *Dahlberg* does not cure this deficiency as the weights are contained in a butt cap 14.

Claims 25 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Vogts, et al.* as applied to claim 24 above, and further in view of *Sledge* (U.S. Patent 6,115,955). Applicants repeat the arguments above with respect to the lack of teaching or enablement by *Vogts et al.* Furthermore, *Sledge* does not cure this deficiency as the weights are contained in a knob 54.

Claims 26-27 and 29-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Tabor* (U.S. Patent 4,467,548) in view of *Vogts, et al.* Applicants repeat the arguments above with respect to the lack of teaching or enablement by *Vogts et al.* Additionally, *Tabor* encases individual compartments 10 within sleeve 3 which does not meet the recited claim limitations.

Claim 28 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Tabor* as modified by *Vogts, et al.* as applied to claim 27 above, and further in view of *Dahlberg, et al.* (U.S. Patent 5,355,611). Applicants repeat the arguments above with respect to the lack of teaching or enablement by *Vogts et al.* and *Tabor*. Furthermore, *Dahlberg* merely teaches weights 16a, 16b, 16c contained within a butt cap 14.

As previously argued with respect to the anticipation rejection, *Vogts et al.* does not make it possible to nest together, or to place weights in abutting relationship together in relation to each other, as well as in relation to adjacent handle portions. Furthermore,

weight 704 of *Vogts et al.* cannot be completely removed from a fishing pole handle. In contrast, Applicants' weights can be selectively removed. Furthermore, *Vogts et al.* only teaches the use of a single weight in the Figure 7 embodiment.

Additionally, *Tabor* discloses an apparatus for counterbalancing a handle comprising a set of stackable balancing weights configured to be removably supported by a handle. Applicants traverse this assertion because *Tabor* merely teaches the provision of a plurality of storage compartments made from clear or translucent material that are capable of being stored within a hollow handle 6 of a fishing rod. The storage compartments are configured for containing fishing equipment such as fishing line (see column 2, lines 48-60).

The Examiner has failed to establish a *prima facie* case of obviousness because the claims clearly require the provision of stackable weights provided in "abutting relation" in a manner that matches a cross-sectional outer surface profile or an outer surface of an adjacent handle component. Such configuration is provided to extend from the handle to provide a handle with a surface hand grip that is provided in combination with the adjacent handle component in the stackable weights (see claim 43). Nowhere is such a feature taught or suggested by the recited prior art references.

Accordingly, it is believed that claims 5, 9-15, 21, and 25-33 are nonobvious and allowable over the prior art of record.

Withdrawal of this rejection is respectfully requested.

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CONCLUSION

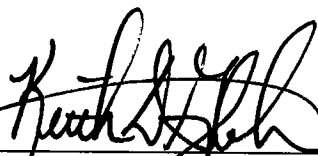
For all the reasons advanced above, Applicants respectfully submit that the application is in condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview before issuance of any such subsequent action.

Respectfully submitted,

Dated: _____

4/25/07

By: _____


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